REMARKS

Claims 1-24 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 8, 15, and 23 to further clarify the invention. In addition, Applicant editorially amends claim 22 for improved conformance with US practice. It is respectfully submitted that this conformity-related amendment has broadened the scope of the claim. The amendment to claim 22 was not made for reasons of patentability.

Summary of the Office Action

Claims 1, 2, 4-9, 11-15, 18-21, 23, and 24 stand finally rejected under 35 U.S.C. § 102(e) and claims 3, 10, 16, 17, and 22 stand finally rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses these rejections in view of the comments, which follow. Applicant also respectfully incorporates by reference arguments submitted in the Amendment under 37 C.F.R. § 1.111 filed on April 13, 2004.

Claim Rejections under 35 U.S.C. § 102

Claims 1, 2, 4-9, 11-16, 18-21, 23, and 24 are rejected under 35 U.S.C. § 102(e) as being unpatentable by U.S. Patent No. 6,029,065 to Shah (hereinafter "Shah"). Applicant respectfully requests the Examiner to *carefully reconsider* this rejection in view of the following.

Claim 1, 8, 15, and 22 are the only independent claims in this group. This response focuses initially on these independent claims.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant's claims. Rejections under 35 U.S.C. § 102 are proper

only when the claimed subject matter is identically disclosed or described in the prior art. Thus,

the reference must clearly and unequivocally disclose every element and recitation of the

claimed invention.

With respect to independent claim 1, as now amended, among a number of unique

features not taught by the cited prior art reference, it recites: "means for selecting a set of

provisioning data from a group of the current set of primary provisionig data and the set of

protected primary provisioning data, and wherein a connection to the data network is set up using

the selected set of provisioning data." Independent claims 8 and 15, as now amended, recite:

"means for selecting a set of provisioning data from a group of the current set of primary

provisionig data and the set of protected primary provisioning data, and wherein a connection to

the data network is established using the selected set of provisioning data." Applicant

respectfully submits that Shah fails to disclose primary provisioning data for data network

access, selecting between the current and protected set of feature codes, and establishing a

connection (setting up a connection) to the data network using the selected set of the

provisioning data.

In general, Shah teaches allowing a user to access features such as call waiting,

conference calling, etc., by using the feature codes the subscriber is accustomed to (col. 1, lines

18 to 21, col. 4, lines 10 to 27). The feature codes are usually a numeric sequence, e.g. *69 (col.

1, lines 26 to 39). The feature codes vary from network to network. Therefore, if the user is in a

visiting network, he or she may be unable to access his or her feature codes (col. 1, lines 40 to

58). To enable the user to use the familiar feature codes, Shah teaches that when a mobile station

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(MS) accesses a visiting network, after the MS is registered, the feature codes of the visiting

network are downloaded into the MS, for example, into the MS's temporary memory (col. 2, line

32 to col. 3, line 9).

As a result, when the user wants to activate or deactivate a certain feature code, the MS

matches the feature code of the home network with the downloaded feature code of the visiting

network and forwards the feature code of the visiting network to the base station (col. 4, lines 10

to 27). In other words, Shah teaches feature codes which are numeric sequences such as *69.

These numeric sequences (feature codes) are used to access additional services offered to the

user, e.g., call waiting, call forwarding, caller id. The services are provided by the phone service

provider. These additional services are phone features offered to the user for convenience.

These phone features are selected using a predetermined alphanumeric sequence entered by the

user (feature code).

Shah teaches feature codes to allow the user to select desired phone features. Shah,

however, does not teach or suggest primary provisioning data. The feature codes of Shah are

used to provide the user with access (activation) to the phone features and not with access to the

data network. In particular, in response to Applicant's arguments, the Examiner alleges "that the

incoming extended features change codes is compared with the extended features change codes

MS. Therefore, it is very clear that the extended features change codes for the mobile phone is

protected provisioning data (col. 8, lines 32 to 40)" (see page 8 of the Office Action). Applicant

respectfully submits that claims 1, 8, and 15 recite "primary provisioning data" and not just

protected provisioning data as alleged by the Examiner. In addition, for the reasons explained

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above, Shah fails to disclose primary provisioning data as set forth in the independent claims 1,

8, and 15.

Next, Applicant respectfully submits that Shah fails to disclose selecting between the

current and protected set of feature codes. In Shah, the user can active or deactivate the feature

codes. But, if as alleged by the Examiner, the current feature codes are the feature codes of the

current network and the protected codes are the feature codes of the home network (numerical

sequences the user is accustomed to using), then Shah clearly fails to teach or suggest selecting

between the two. In fact, in Shah the feature codes of the present network are linked to the

feature codes of the home network. In Shah, the system does not select to use the protected

feature codes as opposed to the feature codes of the home network. In other words, the system

only links the stored feature codes to the feature codes of the current network and the system of

Shah does not select the type of feature codes to use such as selecting the feature codes of the

current network and the feature codes of the home network. In short, Shah fails to teach or

suggest selecting a set of feature codes from a group of the current codes and the protected

codes.

Next, Shah fails to disclose establishing a connection (setting up a connection) to the data

network using the selected set of the provisioning data. In general, Shah teaches that when a

feature is subject to a subscription charge (an extended feature), it requires provisioning. In

other words, the user must be notified of a surcharge and this feature should be activated only if

the user accepts (col. 4, lines 58 to 67).

In particular, Shah teaches that <u>once the MS is on the Traffic Channel</u>, an OTASP Data

Message is sent that an additional fee is charged for the use of the feature and requesting

acknowledgment of acceptance. <u>If accepted, a second OTASP Data Message is sent containing a</u>

<u>Extended Feature Change Code (EFCC)</u> of the visiting network. If the EFCC matches the EFCC

for the mobile station, it is verified by the mobile unit, after which it may be used to unlock the

mobile station, update the feature codes and store the updated feature codes into the phone's

memory. After verification of the programmed data in accordance with OTASP processing, the

process is terminated. If the user refuses the additional billing, no downloading will occur (col.

8, lines 32 to 40).

As is visible from the passage above, Shah teaches OTASP processing for activating

certain extended features. OTASP is used <u>in wireless telecommunication networks</u> and is not

related to data networks or accessing a data network. In fact, from the passage above, it become

clear that Shah is very different from the present invention set forth in the independent claims 1,

8, and 15. Shah discloses <u>matching</u> extended feature <u>codes</u> that vary from network to network.

Shah addresses the problem of not having links between the feature codes of the home network

and the visiting network. As a result, Shah discloses matching the extended feature codes and

<u>creating a link between the two</u> so that the user can use the familiar feature codes of his or her

home network even when the user is roaming in the visiting network.

Shah, however, fails to address the problem of continuous provisioning, where when the

user changes access networks, the primary provisioning data is automatically changed, thereby

requiring constant updates as the MS roams from one access network to another. Moreover,

Shah is not related to accessing the data network, where the provisioning data is usually updated automatically when change of access network occurs. In other words, Shah does not address primary provisioning data used to access the data network. In fact, throughout the entire disclosure of Shah, there is no mention or suggestion of the data network. Shah is not related to a data network or how a data network is accessed. The feature codes, which are user short cuts (numerical sequences the user is accustomed to using) are not related to data network or to accessing a data network. Instead, Shah simply addresses the handling of feature codes when MS switches from one wireless network to another wireless network. In short, Shah does not disclose or even remotely suggests the primary provisioning data for accessing a data network such as the Internet.

That is, Shah only addresses roaming between the wireless networks and matching the feature codes of various networks. Shah does not disclose the MS accessing the data network or setting up a connection with a data network using the selected set of provisioning data. In other words, the feature codes of Shah are not used to connect to a data network. In fact, as explained above, Shah discloses that the user is already registered with the network when the feature codes of the visiting network are downloaded. If the MS is already registered with the visiting network or is already on the traffic channel of the visiting network, then clearly these codes are not used to access a network.

Shah only teaches that no activation (creation of a link) of the extended feature codes will take place without user permission. But Shah fails to teach or suggest setting up a connection with a data network using the feature codes. Moreover, Shah fails to disclose selecting a current

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set of feature codes or the protected set of feature codes. In Shah, the protected feature codes are

linked with the current feature codes. In short, there is no selection between the two types of

feature codes. Also, Shah only teaches numerical codes for activating phone features, as such

Shah fails to disclose primary provisioning data for accessing a data network, as set forth in the

independent claims 1, 8, and 15.

Finally, the Examiner alleges that col. 8, lines 31 to 48 teaches storing the protected

provisioning data, and storing a current set of provisioning data as set forth in claim 1, for

example. Col. 8, lines 31 to 48 recite:

> Once the mobile station is on the Traffic
> Channel, an OTASP Data Message is sent that
> an additional fee is charged for the use of
> the feature and requesting acknowledgment of
> acceptance. If accepted, a second OTASP Data
> Message is sent containing a Extended
> Feature Change Code (EFCC). If the EFCC
> matches the EFCC for the mobile station, it
> is verified by the mobile unit, after which
> it may be used to unlock the mobile station,
> update the feature code(s) and store the
> updated feature code(s) into the phone's
> memory. After verification of the programmed
> data in accordance with OTASP processing,
> the process is terminated. If the user
> refuses the additional billing, no
> downloading will occur. A number of
> different EFCCs may be used for different
> feature codes so that the user may elect the
> feature codes individually to avoid being
> billed for access to all possible optional
> extended features when only one is desired,
> emphasis added.

Applicant respectfully point out that this passage of Shah only deals with <u>updates of the extended feature codes</u>. It does not teach or suggest storing both the current features and the protected features. In Shah, there is no selection between the current features and the protected features. Therefore, it is clear that in Shah, there are <u>no two sets of extended feature codes</u> (a current and a protected one) <u>stored at the same time</u>. Shah only teaches updating extended feature codes. In short, Shah fails to teach or suggest storing a current set of primary provisioning data and a protected set of the primary provisioning data as set forth in claim 1, for example.

Therefore, "means for selecting a set of provisioning data from a group of the current set of primary provisionig data and the set of protected primary provisioning data," and "means for selecting a set of provisioning data from a group of the current set of primary provisionig data and the set of protected primary provisioning data, and wherein a connection to the data network is set up using the selected set of provisioning data," as set forth in independent claim 1 and "means for selecting a set of provisioning data from a group of the current set of primary provisionig data and the set of protected primary provisioning data, and wherein a connection to the data network is established using the selected set of provisioning data," as set forth in claims 8 and 15 are not disclosed by Shah, which lacks primary provisioning data, selecting a current feature code or the protected feature code and using the selected feature code to access a data network.

For at least all of the foregoing reasons, Applicant respectfully submits that Shah does not anticipate the subject matter of claims 1, 8, and 15. Applicant, therefore, respectfully

requests the Examiner to withdraw this rejection of independent claims 1, 8, and 15 and their

dependent claims 2, 4-7, 9, 11-14, 16, and 18-21.

In addition, Applicant respectfully notes that claim 8 recites: "means for storing at least

one set of protected provisioning data that cannot be updated without the intervention of an

access network operator" and claim 15 recites: "means for storing at least one set of protected

provisioning data that cannot be updated without the intervention of an access provider."

Applicant respectfully submits that Shah only teaches confirming activation of the phone feature

that require surcharge. In other words, the EFCC codes of the phone features requiring

surcharge in the current visiting network are downloaded only when the user confirms. Shah

teaches activation of these features without the intervention of an access network operator or the

access provider. In fact, these extended features are only activated with intervention from the

user and not the access network operator or the service provider.

Applicant respectfully submits that Shah fails to disclose not being able to activate the

extended features in visiting networks without intervention of the network access operator or

access provider as set forth in the independent claims 8 and 15, respectively. For at least this

additional reason, Applicant respectfully submits that independent claims 8 and 15 are patentable

distinguishavle from Shah.

Next, with respect to independent claim 23, it recites "when said provisioning data is not

detected, requesting current provisioning data" and "wherein before storing in said storage said

protected provisioning data, the user is queried whether said protected provisioning data is to be

stored." The Examiner alleges that col. 4, lines 20 to 30 of Shah discloses requesting the current

provisioning data, when the provisioning data is not detected. Col. 4, lines 20 to 30 recite:

> The base station responds indicating
> activation or deactivation of the selected
> feature. If the visited network does not
> support a particular feature, the base
> station will respond with an indication of
> that fact, causing a busy signal or some
> other tone to be heard by the user. If the
> mobile unit has a display screen,
> information the phrase "feature not
> available" may be displayed following entry
> of the keystrokes for that feature.

In other words, Shah teaches that if the feature is not activated, then an error message will be

displayed. In other words, if the requested feature is not found, then an error message is

displayed. In short, Shah clearly fails to disclose requesting a current feature code for the

deactivated features. In addition, in Shah, the user is asked to activate or deactivate a feature

code, where the feature codes of the home network are already stored in the MS. In other words,

Shah fails to disclose querying the user whether to store the feature codes. For at least these

exemplary reasons, Applicant respectfully requests the Examiner to withdraw this rejection of

claim 23. In addition, claim 24 is patentable at least by virtue of its dependency on claim 23.

Claim Rejections under 35 U.S.C. § 103

Claims 3, 10, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over

Shah in view of U.S. Patent No. 6,735,441 to Palkisto (hereinafter "Palkisto") and claim 22 is

rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah in view of a newly found

reference, U.S. Patent No. 6,064,880 to Alanara (hereinafter "Alanara"). Applicant respectfully

traverses these rejections in view of the following remarks.

Applicant respectfully traverses this rejection with respect to claims 3, 10, and 17, which

are dependent upon claims 1, 8, and 15, respectively. Applicant has already demonstrated that

Shah does not meet all the requirements of independent claims 1, 8, and 15. Palkisto is relied

upon only for its teaching of using Internet or wireless application protocols.

Specifically, Palkisto is similar to the prior art mentioned in the Application. It attempts

to reduce the signaling load in the GPRS. GPRS comprises of a number of serving support

nodes SGSN, which serve one gateway support node GGSN. These SGSN transmit routing area

update information to and from the GGSN and HLR. Every time a MS moves from the area of

an old support node to the area of a new support node, the routing update information is signaled

to the network and specifically, to HLR where the location of the MS is stored. As a result, a

significant signaling load is generated (col. 4, lines 18 to 35).

Therefore, Palkisto proposes having the support node manage the mobility of the MS and

maintain information on which data transmission IP address is serving each MS at each

particular time. Information on a change in IP addresses within the area of the same support

node is relayed to the gateway node but not to the HLR (col. 5, lines 2 to 7). Palkisto, however,

fails to cure the deficient teachings of Shah. Palkisto fails to teach or suggest "means for

selecting a set of provisioning data from a group of the current set of primary provisionig data

and the set of protected primary provisioning data; and means for setting up a connection to the

data network using the selected set of provisioning data."

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In addition, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine Shah and Palkisto for "increasing the efficiency of the communication system" (see page 5 of the Office Action). Applicant respectfully submits that it is unclear at the very least as to how the packet switched network would increase the efficiency of a wireless network. Shah teaches a home wireless network and a visiting wireless network. Shah has nothing to do with packet switched networks or the Internet or having the MS access the Internet.

Moreover, Applicant respectfully submits that one of ordinary skill in the art would not view a packet switched network or the Internet as a source of increasing efficiency of the wireless communication system as taught by Shah. In short, there is no motivation to combine these two unrelated references in a manner suggested by the Examiner. Shah and Palkisto cannot be validly combined with each other in a rejection under 35 U.S.C. § 103(a).

In addition, as explained above, those skilled in the art would need to make additional modifications not taught in the prior art, in order to combine the references in the manner suggested by the Examiner. Palkisto does not compensate for the above-identified deficiencies of Shah. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1, 8, and 15. Since claims 3, 10, and 17 are dependent upon claims 1, 8, and 15, respectively, they may be patentable at least by virtue of their dependency.

Next, Applicant respectfully traverses the rejection of independent claim 22. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah in view of a newly found reference, Alanara. The Examiner found Applicant's arguments with respect to claim 22

persuasive, and the Examiner acknowledges that Shah fails to teach or suggest "backing up

provisioning data for an access network, an access provider or a user," as set forth in claim 22.

The Examiner, however, now alleges that Alanara, a newly found reference, teaches backing up

provisioning data for an access network as set forth in claim 22. Applicant has carefully studied

Alanara's discussion of archieving the address book stored in the MS and Applicant respectfully

disagrees with the Examiner. In fact, Applicant respectfully submits that the relevance of

Alanara's reference is not understood. Alanara relates to archieving information entered by the

user (in particular, the phone book) so that when the user switches equipment or when data loss

occurs, the phone book and similar user specified information is not lost.

In parituclar, the MS has a Short Code Memory (SCM) for storing user-specified

information. Some of the contents of the SCM is transmitted to a second memory via the

telecommunications network. The second memory stores at least some of the received contents.

Next, the contents from the second memory are transmitted to the MS via the

telecommunications network, and the MS stores the received content. The second memory can

be associated with an Over-the-Air Activation Function (OATF) or with a Short Message

Service (SMS) Cellular Messaging Teleservice (CMT) Message Center (MC). In this manner

the SCM contents are archived at the network level, and can be subsequently downloaded to the

same or a different MS to restore the contents of the SCM (col. 2, lines 23 to 45).

Alanara, however, has nothing to do with provisioning data and especially provisioning

data for an access network. Alanara teaches a back up of <u>user specified information such as a</u>

name and a phone number stored in the address book. Alanara fails to teach or suggest backup of the provisioning data.

In addition, one of ordinary skill in the art confronted with a problem of switching networks and changing feature codes would never have turned to a reference like Alanara, which has nothing to do with feature codes or switching networks. In short, Shah and Alanara taken alone or in any conceivable combination fail to teach or suggest "backing up provisioning data for an access network, an access provider or a user." For at least these exemplary reasons, Applicant respectfully submits that claim 22 is clearly patentable over the combined teachings of Shah and Alanara.

Improper Finality

A Non-Final Office Action issued February 26, 2004, in the above-identified application, in which claims 1-22 were rejected. In particular, in this Non-Final Office Action, claim 22 was rejected as being allegedly anticipated by Shah.

Applicants filed an Amendment on April 13, 2004 (hereinafter "Amendment"), amending claims 1, 4, 8, and 15 for improved clarity. In addition, Applicant added claims 23-24. In the Amendment, however, Applicant did not amend claim 22. In this Office Action dated June 21, 2004 (hereinafter "Office Action"), the Examiner indicated that claims 1-24 are rejected. In particular, the Examiner indicated that the original claim 22 is now rejected under 35 U.S.C. § 103(a) as being obvious over Shah in view of a newly found reference, Alanara, whereas in the previous Office Action it was rejected under 35 U.S.C. § 102(e) as being anticipated by Alanara.

In short, in this Office Action, the Examiner provided one new reference, which was not

previously made of record.

The Examiner alleges that Applicant's amendments necessitated new grounds for

rejections. Claim 22, however, was not amended in any way and was pending in its original

form and as such could not have necessitated new grounds for rejection. In short, Applicant's

response did not necessitate the new grounds for rejection of claim 22. See MPEP § 706.07(a)

which states:

> that a second or any subsequent action on
> the merits shall be final, **except** where the
> **Examiner introduces a new ground for**
> **rejection** that is: (1) not necessitated by
> an applicant's amendment of the claims or
> (2) based on information submitted in an
> information disclosure statement filed
> during the period set forth in 37 C.F.R. §
> 1.97(c)).

Therefore maintaining a final rejection where new rejections are made in the absence of

substantive amendments to the rejected claim by the Applicant, is improper. In view thereof,

Applicant respectfully requests the Examiner to withdraw the finality of the Office Action and

reopen prosecution for the reason that Applicant's Response under 37 C.F.R. § 1.111 filed April

13, 2004, did not necessitate the new grounds for rejecting claim 22.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly invited to contact the undersigned attorney at the telephone number listed below.

Amendment under 37 C.F.R. § 1.116   Attorney Docket No.: Q61623
U.S. Application No.: 09/716,273

The USPTO is directed and authorized to charge all required fees, except for the Issue

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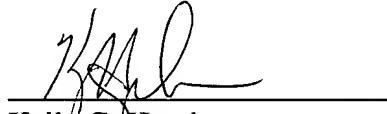
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